

**REMARKS**

Claims 1-20 are pending in the instant application after this amendment cancels claims 21-25. Claims 1, 4, 5, 12, and 13 are amended by this amendment to include the features of canceled claims 21-25, respectively. No new matter is introduced by the amendments, which find support throughout the specification and figures, and specifically are supported at least by figure 8, and at page 13, lines 4-7, of the specification. In view of the amendments and the following remarks, Applicants respectfully request that the pending claims be allowed.

Claims 1-6, 8, and 11-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5,835,087 to Herz (hereinafter referred to as Herz) in view of United States Patent No. 5,946,664 to Ebisawa (hereinafter referred to as Ebisawa). Applicants respectfully traverse.

Claim 1 relates to an in-contents advertising method that includes, *inter alia*, activating in a user terminal in a game program by a user digital contents, and determining that the digital contents have been activated by the user. The method of claim 1 also includes ***counting a number of times that the retrieved advertising information is transferred***, and the amendment to claim 1 adds the feature of ***billing an advertiser for advertising fees calculated based on the number of times that the retrieved advertisement information is transferred***.

Ebisawa apparently relates to a driving game program that includes advertisements which are updated using downloaded information. The Office Action asserts that it would have been obvious to modify Herz with Ebisawa "to attract fun, younger users to the system". "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir.

2000). Applicants submit that combining a news program with a driving game to attract younger users is an improper motivation to combine the references since the references are not compatible and do not suggest the combination.

However, in the interest of expediting prosecution, Applicants amend each of the independent claims to include a feature of the canceled claims of “billing an advertiser for advertising fees calculated based on the number of times that the retrieved advertisement information is transferred”. It is respectfully submitted that none of the references disclose or suggest counting the number of times that a user clicks on advertisements in order for advertisers to get billed only for advertisements that are received. The Examiner takes Official Notice that it is common knowledge in the art to perform this counting (Office Action; page 3, bottom, to page 4, top).

Applicants challenge this Official Notice, citing the significance of this feature as discussed in the specification, and respectfully request a citation in support of each feature rejected based on Official Notice, as required by MPEP 2144.03. As the MPEP states, “[i]n certain circumstances where appropriate, an examiner may take official notice of facts not in the record or rely on ‘common knowledge’ in making a rejection, however *such rejections should be judiciously applied*”. (MPEP 2144.03; emphasis added). MPEP 2144.03 further states:

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be *judiciously applied*. Furthermore, as noted by the court in Ahlert, any facts so noticed should be of notorious character and *serve only to “fill in the gaps” in an insubstantial manner which might exist in the evidentiary showing* made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697; Ahlert, 424 F.2d at 1092, 165 USPQ 421.

(emphasis added). Applicants therefore specifically point out the errors in the Office Action by stating why the noticed fact is not considered to be common knowledge or well-known in the art. In particular, Applicants challenge that it is not “old and well known to count the number of times that a user clicks on advertisements in order for advertisers to get billed only for advertisements that are received”.

The Office Action relies on “clickthroughs” as an example of such a system. However, Applicants submit that clickthroughs are not a proper subject for Official Notice, since the Office Action does not provide a motivation to combine such a system with the two references cited against these claims. Additionally, clickthroughs do not disclose the system presently claimed, which does not require clickthroughs, but rather counts a number of downloads and bills an advertiser based on the number of downloads. Applicants’ submit that the foregoing discussion casts reasonable doubt on the fact on which Official Notice is taken. Applicants assert that the Examiner improperly relies on personal knowledge, thereby undermining the prosecution process by depriving the Applicant of the opportunity to examine and analyze the references. Applicants therefore respectfully request that prior art be cited in regard to each of the above-referenced claims so that Applicants may have the opportunity to respond to prior art rejections.

Claims 2, 3, and 14 depend from claim 1 and are therefore allowable for at least the same reasons as claim 1 is allowable.

Claims 4, 5, 12, and 13 include features similar to those discussed above in regard to claims 1 and 2, and therefore, for at least the same reasons claims 1 and 2 are allowable, claims 4, 5, 12, and 13 are also allowable.

Claims 6-11 and 15-20 depend from one of claims 4, 5, 12, and 13, and are therefore allowable for at least the same reasons as their respective base claims are allowable.

Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz and Ebisawa in view of United States Patent No. 6,385,596 to Wiser (hereinafter referred to as Wiser). Applicants respectfully traverse.

Claim 7 includes the feature of “advertisement information providing system further comprising means for recording the transmission state of said advertisement information, with advertising fees being calculated based on said recording results”. Regarding claims 7 and 9, the Office Action relies on Wiser as alleged disclosure of the features of calculating advertising fees based on records of transmission states. However, Wiser does not relate to advertising fees, but rather apparently discusses buying music downloads. Therefore, none of the references disclose or suggest recording transmissions of advertising and calculating a fee thereby, and therefore these claims are allowable for at least this reason. Additionally, the Office Action asserts that it would have been obvious to combine the references “for advertisers to get paid for high fidelity recording products” (Office Action; page 5, bottom). Applicants challenge this motivation to combine the references since it appears to be a motivation to modify Wiser itself, since the other references do not relate to music products. Therefore, this purported motivation does not provide a proper reason why a practitioner in the art and knowledgeable of Herz and Ebisawa would be motivated to combine those teachings with Wiser.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herz and Ebisawa in view of United States Patent No. 7,146,567 to Duczmal (hereinafter referred to as Duczmal). Applicants respectfully traverse.

Regarding claim 10, the Office Action relies on the new references Duczmal as alleged disclosure of the features of calculating advertising fees based on records of transmission states. Again, the Office Action's purported motivation to combine the references presents a circular argument, stating that "[i]t would have been obvious ... to have included the advertisers selecting from certain information insertion that can be made in order for advertisers to pick from information and time slots that are available." (Office Action; page 6, middle). This does not provide a motivation for a practitioner with knowledge of Herz and Ebisawa to be motivated to combine those references with Duczmal, but rather apparently uses a benefit of Duczmal to motivate a modification of Duczmal, rather than provide a motivation to combine Duczmal with the other references. Applicants therefore also challenge this motivation to combine the references.

### **CONCLUSION**

In view of the remarks set forth above, this application is believed to be in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

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Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,

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